

REMARKS

Claims 1-48 remain pending in the application.

Rejection of Claims 18-34 Under 35 U.S.C. § 101

The Examiner has rejected Claims 18-34 under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

Reconsideration and withdrawal of the rejection is respectfully requested.

Claims 18-34 are directed to a method for rental equipment management for a plurality of rental locations. 35 U.S.C. § 101 provides that "Whoever invents or discovers any new and useful process . . . or any new and useful improvement thereof may obtain a patent therefore, subject to the conditions and requirements of this title." Further, a statutory "process" encompasses "[a] process, art or method . . ." 35 U.S.C. § 100 (b) .

The Examiner contends that Claims 18-34 are directed to non-statutory subject matter in that they are allegedly "mere ideas in the abstract," which "fail[] to recite the use of technology to perform the process." According to the Examiner, Claims 18-34 would constitute statutory subject matter if they recited "a network or computer." Applicant respectfully submits that the Examiner has misapplied the law by equating the lack of computer hardware limitations in the claims at issue as an attempt to claim "abstract ideas." While the Supreme Court has

held that abstract ideas are not patentable subject matter, the present application claims a useful method with real-world application which is not a mere "abstract idea."

In applying the prohibition against patenting abstract ideas, such as mathematical algorithms, the Federal Circuit has held that the required "inquiry simply requires an examination of the contested claims to see if the mathematical concept representing nothing more than a 'law of nature' or an 'abstract idea,' or if the mathematical concept has been reduced to some practical application, rendering it 'useful.'" AT&T Corp. v. Excel Communications, 172 F.3d 1352, 1357 (Fed. Cir. 1999).

The present application is indisputably directed to a useful application, the management of equipment and reservations. It cannot seriously be contended that a method with such a practical application is not useful. In AT&T, the claims at issue were directed to a telecommunications method utilizing a message record for long-distance telephone calls enhanced by the addition of a primary interexchange carrier indicator. Id. at 1353. The Federal Circuit held that "all the claims fall comfortably within the broad scope of patentable subject matter under § 101." Id. at 1361. The Court specifically rejected the defendant's contention that the asserted claims were unpatentable because they lacked physical limitations, holding that "this type of physical limitations analysis seems of little value." Id. at 1359. Thus, contrary to the Examiner's assertion, the recitation of computer hardware or network limitations in Applicant's claim

is not necessary to satisfy 35 U.S.C. § 101, and the rejection should be withdrawn.

REJECTION OF CLAIMS 1-48 UNDER 35 U.S.C. § 102(e)

The Examiner has rejected Claims 1-48 under 35 U.S.C. § 102(e) as anticipated by Swart, U.S. Patent Application Publication No. US 2002/0099613 ("Swart"). The Swart application was filed on December 14, 2000 and claims priority from Application No. 09/594,419, filed on June 14, 2000. Thus, Swart's earliest possible effective date as a Section 102(e) reference is June 14, 2000. See M.P.E.P. § 706.01(f)(1).

Applicant has concurrently filed herewith a Declaration Under 37 C.F.R. § 1.131 establishing that the invention claimed in the present application was conceived and reduced to practice prior to June 14, 2000. Thus, Swart was not "filed in the United States before the invention by the applicant for patent." 35 U.S.C. § 102(e). Accordingly, Swart does not constitute prior art to the present application and should be withdrawn as a reference.

CONCLUSION

In view of the foregoing, it is believed that all claims now pending patentably define the subject invention over the prior art of record and are in condition for allowance and such action is earnestly solicited at the earliest possible date.

Respectfully submitted,

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